

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:
Gentz et al.

Docket No.: PF454P1

Application Serial No.: 09/518,931-Conf. #7173

Art Unit: 1646

Filed: March 3, 2000

Examiner: E. B. O'Hara

Title: Tumor Necrosis Factor Receptor 6 Alpha &
6 Beta

**REQUEST FOR RECONSIDERATION OF DECISION ON APPLICATION FOR
PATENT TERM ADJUSTMENT**

MS Office of Patent Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

Applicants wish to thank the Office for consideration of Applicants' previous Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b) and Request to Amend Entries in PAIR ("Application for Patent Term Adjustment"). However, Applicants hereby request reconsideration of the Patent Term Adjustment indicated in the Decision on Application for Patent Term Adjustment mailed on January 9, 2007, for the present application, and as modified by the Issue Notification. Applicants believe the correct Patent Term Adjustment is 1043, not 622 days.

Briefly, Applicants believe the correct amount of PTO delay is 1169 days, the correct amount of Applicant delay is 126 days and that, therefore, the correct amount of Patent Term Adjustment is 1043 days. Applicants' reasoning for this determination is described in more detail below and in the previous Application for Patent Term Adjustment.

Period of Adjustment of Patent Term due to Examination Delay under 37 C.F.R. § 1.703(a)-(e).

1. The Patent Office calculated three periods of Patent Office Delay prior to payment of the issue fee:

- I. A delay of 213 days for the number of days in the period the application was suspended by the Office from January 17, 2002, to November 18,

2002, due to interference proceedings under 35 U.S.C. 135(a) not involving the application (37 C.F.R. § 1.703(c)(2)). *See* Decision on Application for Patent Term Adjustment mailed on January 9, 2007, at page 3.

- II. A delay of 206 days for the number of days in the period the application was suspended by the Office from July 17, 2003, to February 8, 2004, due to interference proceedings under 35 U.S.C. 135(a) not involving the application (37 C.F.R. § 1.703(c)(2)). *See Id.*
- III. A delay of 306 days for the number of days in the period the application was suspended by the Office from June 9, 2004, to January 8, 2005, due to interference proceedings under 35 U.S.C. 135(a) not involving the application (37 C.F.R. § 1.703(c)(2)). *See Id.*

Applicants disagree with the PTO's calculations for items I-III above. As stated above, PTO delay under 37 C.F.R. § 1.703(a)(3) is calculated as the number of days in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. Applicants' Amendment after Final Rejection mailed on November 20, 2001 qualifies as a reply in compliance with § 1.113(c). The PTO's response to this paper was mailed May, 9, 2005. Thus, the period of PTO delay calculated with respect to these actions should be the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was filed, or March 20, 2002, and ending on the date of mailing of either an action under 35 U.S.C. 132, or May 9, 2005. The number of days between March 20, 2002 and May 9, 2005 is 1146 days, in agreement with the PTO's original calculation for Office delay.

Preliminarily, the Office has divided the Office delay into three segments as illustrated in I-III above and as allegedly supported by 37 C.F.R. § 1.702(c). *See* Decision on Application for Patent Term Adjustment mailed on January 9, 2007, at page 3. However, the Office has cited no support for considering that entries in the system "closing the A/R record and resetting the status with respect to these suspensions" terminated the suspension as required by 37 C.F.R. § 1.702(c). In fact, Applicants argue that these entries in the system "closing the A/R record and resetting the status with respect to these suspensions"

did not in actuality terminate any period of suspension. To support this, Applicants point to the fact that no correspondence was ever sent reopening prosecution nor was any action taken on the part of the Examiner to further the prosecution of this application between any of these periods. As a consequence, each letter of suspension simply maintained the single suspension initiated on January 17, 2002 and there was no termination of the suspension as required by 37 C.F.R. § 1.702(c) until May 9, 2005. Consequently, Applicants respectfully request that the entire period of suspension from January 17, 2002 through the mailing of the non-final Office Action on May 9, 2005, be considered a single period for patent term adjustment purposes, generating an Office Delay of 1146 days.

In addition, the Office has asserted that the Letter Regarding Suspension mailed on January 17, 2002, was a response as contemplated under 37 C.F.R. § 1.702(a). *See* Decision on Application for Patent Term Adjustment mailed on January 9, 2007, at page 2. However, the Office cites no support and the Applicant has found none supporting this proposition that a suspension letter is a responsive communication as contemplated under 37 C.F.R. § 1.702(a). Applicants respectfully assert that a response to a reply to a final Office Action under 35 U.S.C. 132 must further prosecution, either providing a Notice of Allowance, indicating that the amendment does not place the application in condition for allowance, or withdrawing the finality of the rejection and continuing with prosecution. A letter of suspension does none of these. In fact, such a responsive reply to the Applicants response after final Office Action was not provided until the non-final rejection was mailed on May 9, 2005.

2. The Patent Office calculated 23 days of Patent Office delay from the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent is scheduled to issue. *See*, Issue Notification. Applicants agree with this calculation.

3. In view of the foregoing, the correct Period of Adjustment of Patent Term due to Examination Delay under 37 C.F.R. § 1.703 (a) through (e) is equal to the delay described in items 1 and 2 above, or 1169 days.

Reduction of Period of Adjustment of Patent Term under 37 C.F.R. § 1.704(b)-(e)

The Applicants and Patent Office agree that the total Applicant delay during prosecution was 126 days. The Applicants' rationale for the calculation of this delay was presented in the previous Application for Patent Term Adjustment.

Total Patent Term Adjustment

4. Pursuant to 37 CFR § 1.704(a) the final Patent Term Adjustment is the total period of adjustment of the term of a patent under § 1.703(a) through (e), or 1043 days (*see supra* paragraphs 1-2) less the period of time during which the Applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application as defined in § 1.704(b) - (e), or 126 days (*see supra*). Using this calculation the total Patent Term Adjustment for the present application as of the payment of the issue fee would be 1169 -126 days, or 1043 days.

CONCLUSION

Applicants respectfully request that the patent term adjustment for the instant application be reconsidered in light of the facts and circumstances described above. In particular, Applicants maintain that the instant application is entitled to 1043 days of patent term adjustment.

In the event of a favorable decision based on this application, Applicants further request reimbursement of the fee which has been paid pursuant to 37 CFR § 1.18(e) for the present request, since payment of such fee was necessitated by a mistake of the Patent and Trademark Office.

If any further information is required, please call the undersigned at the number listed below. Please charge any additional fees due in connection with the filing of this paper, or credit any overpayment, to Deposit Account No. 08-3425.

Dated: March 7, 2007

Respectfully submitted,

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